

## **REMARKS**

In the outstanding Office Action, the Examiner rejected claims 1 and 3-21. In response, Applicants cancel claims 1 and 3-21 without prejudice or disclaimer, and add new claims 36-51. Claims 36-51 are pending and under consideration.

### **Rejections under 35 U.S.C. §§ 102(b), 103(a)**

The Examiner rejected claims 1 and 3-21 under 35 U.S.C. § 102(b) as allegedly anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Japanese Patent Application Publication No. JP 10-217257 to Akihisa et al. ("Akihisa"). Office Action at pages 2-4.

While not acquiescing to the Examiner's rejections, Applicants cancel claims 1-21 without prejudice or disclaimer. In addition, Applicants add new claims 36-51 that are directed to a method of producing a molding die. Support for new claim 36 can be found at, for example, pages 13-14 of the specification.

Claim 36 recites, in part, "[a] method of producing a molding die for molding an optical element, comprising the steps of . . . processing a surface of the die base body to form a reference surface on the die base body; attaching the die base body onto a processing machine on the basis of the reference surface; and shaving a part of the die base body by the processing machine to form a die face corresponding to an optical surface of the optical element." Applicants respectfully assert that Akihisa does not teach or suggest this.

In contrast, Akihisa discloses a metal mold that creates a cavity section ("8", Fig. 2c) within two amorphous alloy blocks ("1a", "1b", and "1c", Figs. 2a-2c). Akihisa goes

on to teach that the cavity section is then used as a mold to produce molded objects from the blocks. It is unclear whether the Examiner characterized the amorphous alloy blocks as the die base bodies of the instant invention, or whether the Examiner characterized the molded objects produced from the alloy blocks as the die base bodies of the instant invention. However, given either characterization, nowhere does Akihisa teach or suggest “processing a surface of the die base body to form a reference surface on the die base body; attaching the die base body onto a processing machine on the basis of the reference surface; and shaving a part of the die base body by the processing machine to form a die face corresponding to an optical surface of the optical element . . .,” as recited by claim 36. Indeed, Akihisa does not teach or disclose further operations on die base bodies at all, let alone attaching die base bodies onto processing machines for further operations upon the die base bodies.

As such, for at least the above reasons, Applicants submit that Akihisa does not teach each and every element of claim 36. Therefore, Applicants respectfully assert that claim 36 is patentable over Akihisa. Claims 37-51 all directly or indirectly depend from claim 36. Thus, these claims are also patentable over Akihisa for at least the same reasons discussed above for claim 36.

### **Provisional Obviousness-Type Double Patenting Rejection**

The Examiner provisionally rejected claims 1-8 and 19-21 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 8 of copending Application No. 10/079,496. In addition, the Examiner provisionally rejected claims 17-18 under the judicially created doctrine of obviousness-



type double patenting as being unpatentable over claims 3 and 8 of copending Application No. 10/079,496 in view of Akihisa. Initially, Applicant thanks the Examiner for pointing out these potential rejections. Without acquiescing to the Examiner's provisional rejections, Applicants submit that, given at least the reasons stated above, these provisional rejections would be the only remaining rejections in this matter. Thus, "the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent." MPEP 804(I)(B). Applicants will again address this potential issue once the claims in either application are in condition for allowance.

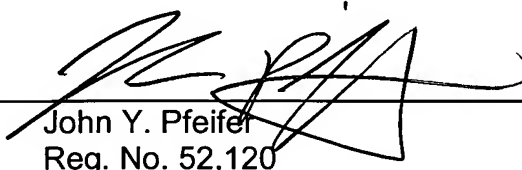
Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

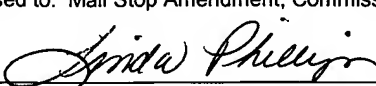
Please grant any extension of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 31, 2005

By:   
John Y. Pfeifer  
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